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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,742	12/21/2000	Debra M. Eckert	0399.1192-008	8580

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EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639


DATE MAILED: 06/06/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy  
Supplemental Restriction  
Office Action Summary

Application No. <b>09/746,742</b>	Applicant(s) <b>Eckert et al.</b>
Examiner <b>Bennett Celsa</b>	Art Unit <b>1639</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above, claim(s) 16-37 and 40-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15, 38, and 39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status of the Claims***

Claims 1-97 are currently pending.

Claims 1-15, 38 and 39 are under consideration.

Claims 16-37 and 40-97 are withdrawn from consideration as being directed to a nonelected invention.

1. Applicant's election of Group I (claims 1-15, 38 and 39) in Paper No. 17 and sequence Id 4 is acknowledged.
2. Upon further search and consideration claims 1-15, 38 and 39 are further restricted in the following manner.

### ***Election/Restriction***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 10-15, 38 and 39, drawn to a fusion protein comprising a soluble trimeric form and a portion of HIV gp41, classified in class 435, subclass 69.7.
  - II. Claim 9, drawn to a D-peptides, classified in class 530 and class 930, various subclasses dependent upon the election of a distinct species..

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4. The inventions are distinct, each from the other because of the following reasons:

5. Compound Inventions I-II are patentably distinct inventions since they encompass peptide compounds which are structurally and/or functionally different (e.g. different amino acid sequences which are capable of separate manufacture and/or use (e.g. diagnostic assays, therapeutic treatments, screening assays). Additionally, each of the separate groups require different and separately burdensome manual and/or computer structure and/or bibliographic searches in patent and literature databases.

6. Because these inventions are distinct for the reasons given above and:

- a. have acquired a separate status in the art as shown by their different classification; and/or
- b. the search required for the different groups are different and require independent and separately burdensome manual/computer sequence, bibliographic and classification searches in patent and literature databases and/or
- c. have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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**Species Election: Patentably Distinct Inventions (Groups I and II above)**

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

a. Claim 1 (group I : "linking claim"): L/D peptide compound comprising:

A soluble, trimeric form of a coiled coil AND

A "sufficient portion of the N-peptide region of HIVgp41 ... to form the pocket of the N-helix coiled-coil of HIV gp41" OR

b. Claim 9 (group II), drawn to D-peptides selected from the group consisting of species (a)-(y');

Peptide compounds within each of the above groups are directed toward structurally and/or functionally different peptides or chemical compounds which are capable of separate manufacture and/or use; and which require different and separately burdensome burdensome manual/computer sequence/bibliographic/classification searches. Additionally, these peptides fail to comprise sufficient core structure to elicit a common activity, and additionally in view of their scope; preclude a complete and meaningful search.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed peptidic or chemical species (E.g. a single compound) , even though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. .

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)

June 4, 2003

BENNETT CELSA  
PRIMARY EXAMINER

